

## REMARKS

### I. Introduction

Claims 1-24, 27-30, 33, and 35 are currently pending in the present application. Claims 1, 30, 33, and 35 are independent. Upon entry of this amendment, which is respectfully requested, new claim 36 will be added. No new matter is introduced by this amendment.

All claims are subject to a restriction requirement imposed by the Examiner in the Non-final Office Action mailed on December 14, 2005 as Part of Paper No./Mail Date 20051206 (hereinafter the "Office Action").

In particular, the Examiner states that "[t]his application contains claims directed to the following **patentably distinct species** of the claimed invention: Species I, drawn to Fig. 8, a survey method positively prompting an attendant to present a query; and Species II, (shown in no Figure) drawn to a survey method for presenting a query only if a timing condition is satisfied." Office Action, pg. 2, first paragraph; emphasis added.

Applicants provisionally elect to pursue Species I, which appears to include claims 1-24, 27-29, 33, and 35. This provisional election is made with traverse. That is, Applicants respectfully disagree with the Examiner's proposed restriction. Applicants request reconsideration of the restriction requirement in light of the following arguments, and pursuant to 37 C.F.R. §1.143.

### II. The Examiner has Failed to Establish a *Prima Facie* Case for Restriction

Restriction of the pending claims is not believed to be appropriate in this case. Specifically, Applicants respectfully submit that the Examiner fails to establish a *prima facie* case for restriction.

#### A. *Proper Basis for Restriction*

##### 1. Generally

Restriction is proper only where an application contains claims directed to two or more **independent or distinct** inventions. See, MPEP §802.01 – which is based, albeit improperly, upon 25 U.S.C. §121 and 37 C.F.R. §1.141. The term "**independent**" is

defined as meaning "that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect". MPEP §802.01. To establish a *prima facie* case for restriction where the basis for restriction is that the different inventions being claimed are "independent", the Examiner must demonstrate "the reasons...why the inventions as claimed are...independent". (MPEP §808).

The term "**distinct**", as used in restriction practice, means that two or more claimed subjects are "(1) capable of separate manufacture, use or sale; and (2) are patentable over each other". *Id.* To establish a *prima facie* case for restriction where the basis for restriction is that the inventions are "distinct", the Examiner must establish (1) "the reasons (as distinguished from the mere statement of conclusion) why the inventions *as claimed* are...distinct", and (2) "the reasons for insisting upon restriction therebetween". MPEP §808.

## 2. Reasonable Number of Species

In some cases, an application is permitted to contain claims directed to two or more independent and distinct inventions. See, 37 C.F.R. §1.141(a). For example, "**more than one species of an invention, not to exceed a reasonable number, may be specifically claimed** in different claims...provided" that the application includes a generic claim and (i) the species claims are written in dependent form, or (ii) the species otherwise include the limitations of the generic claim. *Id.*; emphasis added.

### B. The Examiner's Case as Set Forth

The current ground for restriction is not applicable to the pending claims, and is therefore not a proper basis for restriction. Further, the Examiner fails to provide *any* support for the present restriction. The Examiner makes no statement as to why the alleged species are believed to be distinct. Accordingly, the Examiner fails to satisfy the burden of establishing a *prima facie* case for restriction under MPEP §808, for either "independent" or "distinct"-based restrictions.

## 1. Improper Basis for Restriction

The Examiner contends that the present application contains claims directed to two (2) patentably distinct species (Office Action, pg. 2, first paragraph), based on the inclusion of the following limitations in claim 30: *determining whether the at least one query satisfies a timing condition associated with the merchant*, and prompting an attendant to ask a survey question in the case that the timing condition is satisfied.

Applicants respectfully note that this limitation is a species of a genus described in the other pending claims. Independent claims 1, 33, and 35, for example, all recite limitations directed to prompting an attendant to ask a survey question/provide a survey to a customer. Applicants note that these limitations, as currently claimed, cover all manners of prompting an attendant to ask a survey question/provide a survey, including cases where the prompting is based upon a timing condition.

Accordingly, the multiple species grounds for restriction does not appear to apply to the pending claims.

## 2. A *Prima Facie* Case for "Distinct" Restriction is not Established

Even if the current ground for restriction was somehow properly based, the Examiner fails to establish a *prima facie* case for "distinct"-type restriction. For example, no reasons for believing the claimed inventions are "distinct" have been set forth, nor has the second requirement of presenting reasons for insisting upon restriction been complied with. The Examiner fails to show that (1) that each claimed invention "has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search", (2) that even if classified together they have formed separate subjects for inventive effort, or (3) that a different field of search is required. MPEP §808.02. Absent such showings as required by MPEP §808.02, no *prima facie* case for restriction under the "distinct" theory is established. Where "the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions." *Id.*

### **3. The Examiner has Failed to Establish an Undue Burden**

Even if a *prima facie* case for restriction establishes that an application includes independent or distinct inventions, restriction is not proper "[i]f the search and examination of [the] entire application can be made without serious burden." MPEP §803. Applicants respectfully assert that restriction is not proper in this case because there is no indication that any serious burden exists. In particular, (1) there is no separate classification of the alleged Species which would necessitate a separate field of search; (2) the alleged Species can be searched using the same field of search without unduly burdening the Examiner; and (3) the alleged Species are not related to any class of invention which has achieved a separate status in the art. See, MPEP §808.02. In general, Applicants believe that the claims all can readily be searched and examined together without undue burden on the Examiner. Thus, even if the Examiner had set forth a *prima facie* case for restriction and had relied upon proper grounds for restriction, restriction would still not be proper in this case.


### III. Conclusion

In view of the foregoing, Applicants respectfully request that the restriction requirement be withdrawn upon reconsideration. All claims currently remain in the case and are believed patentable. Applicants respectfully request allowance of the pending claims.

Alternatively, if there remain any questions regarding the present application or the cited reference, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Carson C.K. Fincham at telephone number 203-461-7017 or via electronic mail at [cfincham@walkerdigital.com](mailto:cfincham@walkerdigital.com), at the Examiner's convenience.

Respectfully submitted,

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